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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,924	09/11/2000	Glen T. Cunkle	A-22082/P2/CGC 2041	4000

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CIBA SPECIALTY CHEMICALS CORPORATION
PATENT DEPARTMENT
540 WHITE PLAINS RD
P O BOX 2005
TARRYTOWN, NY 10591-9005

EXAMINER

ALVO, MARC S

ART UNIT	PAPER NUMBER
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1731

13

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/658,924

Applicant(s)

CUNKLE ET AL.

Examiner

Steve Alvo

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

The election of species requirement was made Final in Paper No. 6.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as obvious over WO 99/05108.

WO 99/05108 teaches, page 55, example (g), a compound of the formula: (N,N,N',N'-Tetramethyl-N,N-bis-[3-(1-oxyl-2,2,6,6-tetramethylpiperidin-4-yloxy)-propyl]-hexamethylenediammonium Dibromide. See Example 1 and Abstract, for using 0.5 to 0.1% of the elected species for preventing loss of brightness and for enhancing resistance to yellowing of a lignin containing pulp, e.g. chemimechanical and thermomechanical. See Abstract for adding UV absorbers and polymeric inhibitors and metal chelating agents as coadditives. The claimed N,N,N',N'-Tetramethyl-N,N-bis-[2-(1-oxyl-2,2,6,6-tetramethylpiperidin-4-yloxy)-ethyl]-hexamethylenediammonium Dibromide would have been an obvious variant of N,N,N',N'-Tetramethyl-N,N-bis-[3-(1-oxyl-2,2,6,6-tetramethylpiperidin-4-yloxy)-propyl]-hexamethylenediammonium Dibromide of Example (g) on page 55 of WO 99/05108. Applicant should compare the claimed N,N,N',N'-Tetramethyl-N,N-bis-[2-(1-oxyl-2,2,6,6-tetramethylpiperidin-4-yloxy)-ethyl]-hexamethylenediammonium Dibromide to the N,N,N',N'-Tetramethyl-N,N-bis-[3-(1-oxyl-2,2,6,6-tetramethylpiperidin-4-yloxy)-propyl]-hexamethylenediammonium Dibromide of WO 99/05108.

Art Unit: 1731

The species of WO 99/05108 would have been an obvious modification of the species of WO 99/05108. Besides the claims call for a sub-group Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification has been amended by changing the compound of Example 18. Such an amendment changes the scope of the claims when read in view of the specification.

The amendment filed September 17, 2001 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The specification has been amended by changing the compound of Example 18.

Applicant is required to cancel the new matter in the reply to this Office action.

Applicant has argued that Example 18 is derived from Example 16 and would result in the ethyl compound added by amendment and not the propyl compound of the original disclosure. Applicant should submit an affidavit stating that the ethyl form is the only form that can be derived from the compound of Example 16.

The Declaration is insufficient to overcome the new matter rejection. Dr. Crunkle in the Declaration does not state what is reacted in Example 16 and or 18. It is not state how 5.0 g of 4-(2-Dimethylamino)ethoxy-1-oxyl-2,2,6,6-tetramethylpiperidine reacts with 5.05g of 1,6-dibromohexane to form N,N,N',N-Tetramethyl-N,N-bis-[2-(1-oxyl-2,2,6,6-tetramethylpiperidin-4-yloxy)-ethyl]-hexamethylenediammonium Dibromide . Would any products, e.g. (N,N,N',N'-

Art Unit: 1731

Tetramethyl-N,N-bis-[3-(1-oxyl-2,2,6,6-tetramethylpiperidin-4-yloxy)-propyl]-hexamethylenediammonium Dibromide, also be formed? Or would only N,N,N',N'-Tetramethyl-N,N-bis-[2-(1-oxyl-2,2,6,6-tetramethylpiperidin-4-yloxy)-ethyl]-hexamethylenediammonium Dibromide be formed.

Applicant has not argued that the "ethyl", N,N,N',N'-Tetramethyl-N,N-bis-[2-(1-oxyl-2,2,6,6-tetramethylpiperidin-4-yloxy)-ethyl]-hexamethylenediammonium Dibromide, is not an obvious variant of the "propyl" (N,N,N',N'-Tetramethyl-N,N-bis-[3-(1-oxyl-2,2,6,6-tetramethylpiperidin-4-yloxy)-propyl]-hexamethylenediammonium Dibromide.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

When filing an "**Official**" FAX in Group 1730, please indicate in the Header (upper right) "**Official**" for papers that are to be entered into the file. The "**Official**" FAX phone numbers for this TC 1700 are:

Application/Control Number: 09/658,924
Art Unit: 1731

Page 5

Non-Final Fax: (703) 872-9310

After-Final FAX: (703) 872-9311.

When filing an **“Unofficial”** FAX in Group 1730, please indicate in the Header (upper right) **“Unofficial”** for Draft Documents and other Communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers. The **“Unofficial”** FAX phone number for this Art Unit (1731) is **(703) 305-7115**.

Any inquiry concerning this communication or earlier communications from the **primary examiner** should be directed to **Steve Alvo** whose telephone number is **(703) 308-2048**. The Examiner can normally be reached on Monday - Friday from **6:00 AM - 2:30 PM (EST)**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Steve Griffin, can be reached on 703-308-1164.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Group receptionist** whose telephone number is **703-308-0661**.

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Art Unit: 1731

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MSA
12/16/02



STEVE ALVO
PRIMARY EXAMINER
ART UNIT 1731